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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,509	12/19/2000	Masaki Ito	FUJ 17.715(100794-11514)	7520
26304 7590 02/24/2009 KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			EXAMINER KANG, PAUL H	
			ART UNIT 2444	PAPER NUMBER
			MAIL DATE 02/24/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/741,509	Applicant(s) ITO ET AL.	
	Examiner Paul H. Kang	Art Unit 2444	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thurlow et al., US Patent No. 6,457,879 B1 in view of Cloutier et al., US Patent No. 6,535,586 B1.**

3. As per claim 7, Thurlow discloses a router device used for a packet communication system accommodating one or more terminals and comprising:

an agent reception (i.e., control unit) and transfer unit which, when at least one of said terminals is in an incommunicable state, receives e-mail instead of a user of a terminal that is in the incommunicable state and transfers the received e-mail to a desired transfer destination (See Thurlow, col. 3, lines 37 – 63 and col. 4, lines 46-67).

However, Thurlow does not explicitly teach the system wherein the agent reception and transfer unit decides, without receiving a whole of the e-mail except for a title of the e-mail and an address of a transmission origin of the e-mail, whether or not the e-mail is to be received by the agent reception and transfer unit.

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In the same field of endeavor, Cloutier teaches a system wherein the agent reception and transfer unit decides, without receiving a whole of the e-mail except for a title of the e-mail and an address of a transmission origin of the e-mail, whether or not the e-mail is to be received by the agent reception and transfer unit (Cloutier, fig. 2 and col. 4, line 40 - col. 5, line 22 and col. 5, lines 40-60).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the known filtering techniques of Cloutier into the email system of Thurlow for the predictable result of filtering emails prior to receiving the entire email.

4. As per claim 8, Thurlow-Cloutier teaches the system wherein the agent reception and transfer unit which receives e-mail instead of the user, including one or more prescribed characters in a title of the received e-mail, and transfers the received e-mail to the desired transfer destination (Cloutier, fig. 2 and col. 4, line 40 - col. 5, line 22 and col. 5, lines 40-60).

15. As per claim 9, Thurlow-Cloutier discloses if the prescribed characters are included in the title of the e-mail obtained without receiving the whole of the email, the agent reception and transfer unit decides that the email is not to be received by the agent reception and transfer unit, refuses reception of the email, and keeps the email in an unread state (Cloutier, fig. 2 and col. 4, line 40 - col. 5, line 22 and col. 5, lines 40-60).

16. As per claim 10, Thurlow-Cloutier discloses if the address of the transmission origin of

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the e-mail obtained without receiving the whole of the email agrees with an e-mail address used by the agent reception and transfer unit, decides that the email is not to be received by the agent reception and transfer unit, refuses reception of the email, and keeps the email in an unread state (Cloutier, fig. 2 and col. 4, line 40 - col. 5, line 22 and col. 5, lines 40-60).

Response to Arguments

5. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection. The applicants argued that Thurlow and Leong either alone or in combination failed to teach the newly added limitation wherein the agent reception and transfer unit decides, without receiving a whole of the e-mail except for a title of the e-mail and an address of a transmission origin of the e-mail, whether or not the e-mail is to be received by the agent reception and transfer unit. The new grounds of rejection teaches this feature.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H. Kang whose telephone number is (571) 272-3882. The examiner can normally be reached on IFP.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul H Kang/
Primary Examiner
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